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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,644	09/08/2003	Rudolf J. Dams	57952US002	2822

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EXAMINER
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SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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05/05/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/657,644	<b>Applicant(s)</b> DAMS ET AL.	
	<b>Examiner</b> Rabon Sergent	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-11, 13-16 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11, 13-16 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/12/07, 3/24/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

1. Newly submitted claims 26-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention of claims 26-32 is distinct from the invention of the originally presented invention, because the invention of claims 26-32 introduces a previously unclaimed polyisocyanate reactant and further differs in that the new claims fail to require that either reactant (i) or reactant (ii) contain an isocyanate group. Accordingly, the resulting polymer is structurally distinct from the originally presented invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 3-11, 13-16, and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has reviewed the specification and has not found support for the R<sup>1</sup> and R<sup>2</sup> species, “polyhydroxyalkylene”, set forth within claims 24 and 25.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have failed to specify a basis for the claimed weight percent value. It is unclear if applicants are claiming a composition that contains between 0.01% and 5.0% by weight of the fluorinated polyether isocyanate derived silane, based on the total weight of the composition, including the solvent. Applicants claim can be interpreted as requiring that the solvent is such that only 0.01% to 5.0% of the fluorinated polyether isocyanate derived silane be dissolved while leaving the remaining quantity undissolved; however, while this interpretation is most reasonable in view of the language, it is not seen as practical or logical. Clarification is required.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 3-11, 13-16, and 22-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-4, 6-10, and 18-24 of copending Application No. 10/729,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter is encompassed by the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Despite applicants' arguments, the instant claims are open to the inclusion of additional components; therefore, the presence of additional components within the copending claim set does not distinguish the instant invention from that of the copending claim set. Similarly, the copending claim set is open to the inclusion of additional components, including conventional additives such as surfactants; therefore, the presence of the surfactant is not considered to distinguish the respective claim sets. Furthermore, the copending claim set encompasses coated articles and methods of coating; therefore, applicants' conventional substrates are considered to be rendered obvious by the copending claim set.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5-11, 13-16, and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al. ('272).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Moore et al. disclose fluorinated polyether silane compositions and their application to substrates, such as ceramics and glass. Moore et al. further disclose that the fluorinated polyether silanes may be produced by reacting isocyanate reactive perfluorinated compounds that correspond to applicants’ claimed fluorinated polyether compound with isocyanate functional silane compounds that correspond to applicants’ claimed silane compound. The reference further teaches that solvents, including fluorinated solvents, are utilized within the compositions. See abstract; columns 3-5; column 11, lines 13+; and Example B within column 13.

8. Applicants have argued that Moore et al. do not teach the fluorinated polyether isocyanate derived silane as presently defined. In response, the examiner has considered the teachings of the reference and finds no patentable distinction between the subject matter of the claims and the reference. Applicants have failed to provide any clear rationale or support for their position.

9. Claims 5-11, 13-16, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/30848.

The reference discloses fluorinated polyether silane compositions and their application to such substrates as ceramics and glass. The reference further discloses that the fluorinated polyether silanes may be produced by reacting isocyanate reactive perfluorinated compounds

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that correspond to applicants' claimed fluorinated polyether compound with isocyanate functional silane compounds that correspond to applicants' claimed silane compound. The reference further teaches that fluorinated solvents may be utilized within the compositions. See pages 4-9 and 11, and especially examples B and D within page 12.

10. As with Moore et al., applicants have argued that WO 02/30848 does not teach the fluorinated polyether isocyanate derived silane as presently defined. In response, the examiner has considered the teachings of the reference and finds no patentable distinction between the subject matter of the claims and the reference. Applicants have failed to provide any clear rationale or support for their position.

11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

As aforementioned within paragraphs 7 and 9, the primary references disclose solvent containing fluorinated polyether silane compositions which are considered to meet those claimed; however, the primary references are silent with respect to the incorporation of surfactants or fluorosurfactants into the composition. However, the use of surfactants, such as fluorosurfactants, within fluorinated coating compositions was well known at the time of invention. This position is supported by the teachings of Brown at column 19, lines 5-7, Scicchitano et al. at paragraph [0081], and WO 01/34670 at page 9, lines 16+. Since it has been held that it is *prima facie* obvious to use a known compound for its art recognized purpose, the position is taken that it would have been obvious to utilize the claimed fluorosurfactants in their



art recognized capacity as additives for fluorinated coating compositions, so as to arrive at the instant invention. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

12. Applicants have essentially argued that the instant invention yields unexpected results, as compared to WO 02/30848; however, applicants' response is deficient for the following reasons. Firstly, applicants' arguments do not address the Moore et al. reference. Secondly, the relied upon showings must be commensurate in scope with the claims; however, the rejected claims require the use of a surfactant, and it appears that only Example 15 utilizes a surfactant. However, even Example 15 is not commensurate in scope, because it encompasses additional components, such as water and acetic acid, that are not required by the claims. In further support of this position, the scope of the claims, as well as the prior art, encompasses a much greater scope of reactants than is represented by Example 15. Lastly, it is by no means clear that the relied upon example of WO 02/30848 is representative the most relevant teachings of the reference, because the most relevant teachings are considered to be those concerned with the production of urethane containing or isocyanate derived compositions; however, the relied upon example was not produced using an isocyanate reactant.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

R. Sergent  
April 26, 2008